

REMARKS/ARGUMENTS

STATUS OF THE CLAIMS

Claims 1-12 and 23-24 are pending.

Claims 1 and 7 were amended to delete the final “wherein” clause.

Claim 2 was amended delete the phrase “selected standard gene expression profiles.”

Additional minor changes were made to simplify and clarify the language of the claim.

Claims 3 and 8 were amended to recite “product” rather than “product information” in several places. This change better clarifies the invention and is supported by the specification at page 5, line 24 to page 6, line 2.

Claims 4 and 9 were amended to recite “displaying product information” and “providing a hyperlink.” These changes clarify the invention and are supported by the specification at page 5, lines 20-21, and page 6, lines 3-5.

Claims 10 and 12 were amended to recite “a computer readable medium having encoded thereon a set of instructions for.” In addition, the various “means for” clauses were deleted. Each of the limitations previously described with “means for” was amended with specific language describing the function carried out by the instructions. These amendments to the claims are supported by the specification at *e.g.*, page 2, lines 29-31, Figure 2, and associated description of Figure 2 at page 14, line 10 – page 15, line 3.

New claims 23 and 24 depend from claims 3 and 8, and simply recite one of the list of products recited in the independent claims. These claims are supported by the specification at page 5, line 30.

Other minor changes were made to the claims to remedy obvious typographical and grammatical errors and should be obvious from the context.

No new matter is added in any of the above amendments. Applicants believe that the amendments address the Examiner’s rejections and place the claims in a form for allowance.

ENABLEMENT REJECTION OF CLAIMS 1-9 SHOULD BE WITHDRAWN VIEW OF AMENDMENT

Claims 1-9 were rejected for lack of enablement. The Examiner alleged that the phrase “wherein the product enables the user to test a hypothesis based on the correlation of the first and

second database records [or drug signatures]” is not enabled by the specification as originally filed. While correctly observing that “the skill in the art of bioinformatics is high,” the Examiner went on to determine that “it would require undue experimentation for one of skill in the art to determine what hypotheses can be formed, and then how to use the product to test the hypothesis.”

Applicants respectfully disagree with the Examiner’s assessment of the original specification and direct the Examiner to specific disclosure of “typical hypotheses” at e.g., page 4, lines 24-27, and “exemplary products” at e.g., page 5, line 24 to page 6, line 2. Applicants submit that it would require little or no experimentation for one of skill in the art to test any of the disclosed exemplary hypotheses such as “identification of genes characteristic of a disease state” with any of the disclosed exemplary products such as a “DNA microarray.” Applicants maintain that the disclosure is fully enabling for one of skill in the art to practice the full scope of the claimed method to select a product for testing a hypothesis.

However, in order to expedite prosecution, while not agreeing to the Examiner’s determination regarding the requirement of undue experimentation, Applicants have amended the claims to delete the offending phrase. Applicants have thereby obviated the rejection.

WRITTEN DESCRIPTION, OMITTED ELEMENTS AND INDEFINITENESS REJECTIONS OF CLAIM 10 AND 12 SHOULD BE WITHDRAWN IN VIEW OF AMENDMENTS

Claims 10 and 12 were rejected under § 112, ¶ 1 for lack of written description. Specifically, the Examiner alleged that the recitation of “means for” language in the claims was not supported by description of specific related structures in the specification. Similarly, the Examiner rejected claims 10-12 under § 112, ¶ 2 for failing to disclose the “essential elements” associated with these “means for” clauses, and further for being indefinite for not setting forth specific structures for performing the means recited.

Applicants have amended claims 10 and 12 so that they no longer recite “means for” and therefore no longer invoke § 112, ¶ 6. As amended, the claims recite “a computer readable medium having encoded thereon a set of instructions for” and a listing of the various functions carried out by the instructions. These amendments to the claims are supported by the specification at e.g., page 2, lines 29-31, Figure 2, and associated description of Figure 2 at page

14, line 10 – page 15, line 3. Applicants believe that in view of the deletion of the “means for” language and amendment of the claims with the functional description of the computer encoded instructions, they have fully complied with § 112, ¶¶ 1 and 2 for claims 10 and 12. Applicants respectfully request that the rejections be withdrawn.

INDEFINITENESS REJECTIONS OF CLAIMS 2-4, 7, 8, AND 9 SHOULD BE WITHDRAWN
IN VIEW OF AMENDMENTS

Claim 2 has been rejected for lack of antecedent basis. The Examiner has noted that “[c]laim 1 no longer recites ‘selected standard gene expression profiles,’ or any other profile. Therefore, all the limitations to the correlation information of the profiles lack basis.” Applicants respectfully disagree and point out that claim 1 still recites “profile information comprising a representation of the expression level of a plurality of genes in a cell exposed to a standard compound” as one of the data types for which correlation information may be determined according to the method of the claims. Applicants have amended claim 2 so that it no longer recites the specific phrase “said selected standard gene expression profiles,” but have maintained recital of “profiles” and believe that this recital is supported by claim 1 and the specification generally. Therefore, Applicants request that this rejection be withdrawn.

Claims 3 and 8 were rejected for lack of antecedent basis for the recital of “relevant product information” in the base independent claims. Applicants have deleted the term “relevant” from claims 3 and 8. The rejection is thereby obviated and should be withdrawn.

Claims 4 and 9 were rejected for indefiniteness with respect to the phrase “product information further comprises a hyperlink.” Specifically, the Examiner questioned whether “one [is] purchasing the data, or a piece of DNA?” Applicants answer that both are embodiments of product information within the scope of the invention. The specification (*see e.g.*, page 8, lines 5-12) contemplates both product information regarding both “physical” products such as bioassay kits and reagents, and “information-based” products such as sequence data. In addition, the specification contemplates “product information” as including information relevant to purchase such as price, manufacturer, availability, etc. (*see e.g.*, page 8, lines 23-26). The specification contemplates that product information may include hyperlinks that allow access to product information (*see e.g.*, page 5, lines 20-21). Thus, for example, product information regarding a

bioassay reagent may include hyperlinks to information regarding its price or availability. In view of the discussion throughout the specification regarding various aspects of “product information,” Applicants believe that the metes and bounds of claims 4 and 9 are clear and unambiguous, and the rejection should be withdrawn.

Applicants have corrected the typographical error “production information” in claim 7, step (f) so that it now reads “product information.” It is believed that the claim now conforms with § 112 ¶ 2.

CONCLUSION

Applicants believe that the application is in good and proper condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 463-8133.

Respectfully submitted,

Date: September 20, 2005



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